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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215087
Party	Plaintiff U.S. Marine Corps
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Submission	Motion to Amend Pleading/Amended Pleading
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial No. 85936128

In the matter of Trademark Opposition No. 91215087

For the mark: MARINE ONE DOWN

Published in the Official Gazette on 29 October 2013

UNITED STATES MARINE CORPS (OPPOSER)
3000 MARINE CORPS PENTAGON
ROOM 4B548
WASHINGTON, DC 20350-3000

v.

PETER J. HEALY ("APPLICANT")
P.O. BOX 1523
MORRO BAY, CA 93443

OPPOSER'S REPLY BRIEF IN RESPONSE TO DEFENDANT'S OPPOSITION TO PLAINTIFF'S MOTION FOR LEAVE TO FILE AMENDED NOTICE OF OPPOSITION

The Opposer, the U.S. Marine Corps, respectfully files this Reply Brief to address and rebut assertions made by the Applicant in the document it filed on May 19, 2015, titled "Defendant Peter J. Healy's Opposition to Plaintiff's Motion for Leave to File Amended Notice of Opposition" (hereinafter "Applicant's Objection").

I. Opposer's Intention is Not to Suppress Speech, But to Prevent Infringement, Dilution, and Other Harm To Its Trademark

The Opposer's motivation in opposing the Applicant's trademark application on the name MARINE ONE DOWN has nothing to do with free speech or the 1st Amendment. The Applicant appears to believe that the Opposer cannot tolerate a video game that would dare "cast doubt on the infallibility of Plaintiff's personnel." In other words, Applicant appears to believe that the main motivation behind the instant trademark opposition is to prevent the creation and sale of a video game that would suggest to the public that the President's helicopter could ever be brought down, and that such an unthinkable scenario should be prevented at all costs. On the

contrary, Opposer's intention is to prevent the registration of a name as a U.S. trademark that, in the Opposer's view, would infringe and dilute the Opposer's trademark rights in the name MARINE ONE®, and would otherwise run afoul of trademark law and other authorities. In other words, it's not the *game*, it's the *name*. Indeed, the Opposer notes that two-thirds of the Applicant's applied-for mark consists of the Opposer's registered trademark, MARINE ONE®. Had the Applicant chosen a different name that did not incorporate a Marine Corps trademark, the Opposer would not file to oppose the application. It is not the concept of a video game in which the President's helicopter could be brought down that offends the Marine Corps, it is the proposed name that offends us.

II. Applicant Would Not Be Prejudiced By the Timing of Opposer's Amendment

The Applicant has asserted that the Opposer's Motion to Amend would be prejudicial because of the timing thereof. The Opposer respectfully asserts that it has made every effort to ensure that the Applicant not be prejudiced in any way by its filing to amend. Indeed, when it became apparent to the Opposer that there was significant evidence (both in its discovery responses and from real-world investigations) that Applicant lacked of a bona fide intention to use the mark in commerce, and that case law supported the adding of an additional basis to its Opposition, the Opposer recognized that in the interests of fairness and good faith it should offer to the Applicant that Discovery be reopened, and so offered.

Additionally, through a series of unfortunate circumstances here at the Pentagon, the Opposer's responses to the Applicant's discovery requests were delayed in reaching the Applicant. Suffice it to say that the Pentagon's mail room, due to many layers of security precautions (as a result of both the September 11 attacks and the anthrax attacks later that same year), exacerbated by failures within the Marine Corps' staff to properly deliver the documents to the Applicant, the Applicant's receipt of Opposer's discovery responses were delayed. In the interests of fairness and good faith, the Opposer offered to reopen Discovery so as not to prejudice the Applicant. Indeed, on April 27, 2015, counsel for Opposer sent the following email to the Applicant:

> "Peter, I hope you had a good weekend. I'm getting ready to file a Motion to Amend the Opposition. If granted, it might cause you to want to conduct further discovery. We also had the unfortunate delays in you receiving our responses to your discovery requests. With these issues in mind, would you want to mutually consent to reopening the discovery period? Please let me know and we can discuss timeframes, etc. Thanks."

After receiving no response, on April 28, 2015, Opposer followed-up with this email to the Applicant:

> "Peter, Sorry to pester, the Plaintiff's testimony period ends May 1, and your pretrial disclosures are due May 16. As such, it might be preferable, if we are going to file to extend Discovery, to do that now rather than wait. In either event, I will need to file this Motion to Amend today or tomorrow, and if we are going to extend Discovery it might make sense to do it all at once. If not, that's fine. Call me if you want to discuss."

Later that same day, when Applicant inquired as to the nature of the Opposer's planned amendment, counsel for Opposer sent the following email to the Applicant:

> "My original Notice of Opposition asserted likelihood of confusion, false connection, and a number of other grounds. I am filing to amend the Notice of Opposition to add an additional ground, that being that you do not have a bona fide intention to use the mark in commerce. To the extent to which you might wish to conduct additional discovery to later rebut this assertion, I am offering to you the opportunity to reopen and extend discovery. It's fine if you decline, however. Rule 15(a) of the Federal Rules of Civil Procedure allows for leave to amend. Please let me know what you decide."

Indeed, as is shown from the email record, the Opposer acted in good faith, and not in a manner that was intended or likely to cause prejudice to the Applicant. The Opposer's intention in filing to amend its Notice of Opposition was geared solely toward advancing an argument that the Applicant's lack of a bona fide intention to use the mark in commerce rendered its trademark application as fatally flawed, a view supported by the case law cited by the Opposer in its Brief. Further, the Opposer took all practical measures to avoid any prejudice on the Applicant, and remains more than willing to do so.

III. Plaintiff's Basis for Amending is Not "Absurd," And Is Supported By Case Law

The Opposer respectfully rebuts the Applicant's assertion that the Opposer's legal basis for seeking an amendment to its Notice of Opposition is "absurd," noting that an applicant's lack of a bona fide intention to use a mark in commerce is an absolutely sound basis, and is supported by the case law cited by the Opposer. Additionally, Opposer asserts that in the Applicant's Objection, the Applicant offers further proof that it has "ceased any work on developing" any of the goods cited in its application. Indeed, Mr. Healy plainly admits as much, with these statements:

> "Meanwhile Applicant, is dead in the water, so to speak, in as much as his trademark is encumbered."

> "... the Applicant is greatly hampered in developing the commercial potential of the subject mark."

> "It is on the basis of the foregoing and other commercial calculations, some of them proprietary, that Applicant has not yet sought to publicly market the subject mark."

Further, the Applicant has gone to great lengths to explain how the video game industry requires significant project funding. In doing so, the Applicant appears to be claiming that the vagaries and vicissitudes of the video game industry should somehow create a "free pass" or exception to the requirements of trademark law, and that they somehow excuse the Applicant's acknowledged status of being "dead in the water." The Opposer respectfully asserts that if the Applicant's efforts to use the mark in commerce are indeed "dead in the water," then that is proof of the Applicant's lack of a bona fide intention to use the mark in commerce, and therefore

the application should be refused as having failed to meet the minimum standard of Section 1(b) of the Trademark Act.

As an aside, the Opposer notes that the Applicant also appears to be laboring under the misconception that the Opposer somehow has some responsibility to use the mark in commerce, which has no basis in trademark law. Opposer points to two statements within Applicant's Objection:

> "In response to any and all discovery requests from Applicant, Plaintiff never indicated an intent to use the subject mark commercially."
>
> "In addition, as to the purported concern of Plaintiff that Applicant is squandering the trademark by not actually intending to use it – of all the discovery responses received for Plaintiff, and all communications with Plaintiff counsel, not once has there been the slightest indication that Plaintiff had any intention of ever using the subject mark in commerce – not a hint, not once."

With all due respect, so what? The Opposer is at a loss as to why its use, non-use, or intention to use or not use the mark MARINE ONE DOWN is at all relevant to these proceedings, or why this should be held against the Opposer. At issue is the Applicant's failure to take steps evidencing a bona fide intention to use the mark in commerce, a requirement set forth in Section 1(b) of the Trademark Act. The Opposer's conduct or posture relevant to the applied-for mark is completely irrelevant. Is the Applicant advancing the argument that Opposer's failure to use MARINE ONE DOWN should be held against it? Is the Applicant asserting that the Opposer has some affirmative duty to use any and all iterations and/or extensions of its trademarks in order to protect them against abuse by third-parties? The Opposer's assertions as to the Applicant's "squandering the trademark by not actually intending to use it" speak to the Opposer's assertion that the Applicant lacks a bona fide intention to use the mark in commerce, and the Opposer's actions (or lack thereof) are not germane.

IV. Opposer Does Not Want to Re-open Discovery For Its Own Benefit

The Applicant has asserted that the Opposer "apparently want (sic) to reopen discovery to have another bite at the apple." The Opposer respectfully disagrees, as this is simply not true. As is graphically illustrated by the emails referenced above, the Opposer deeply regretted the delays experienced by the Applicant in receiving Opposer's discovery responses, and also sought to mitigate any chance of prejudice by allowing the Applicant additional time to conduct discovery. The Opposer's actions were not based on any desire to "belatedly … cure" any lack of discovery on its own part, nor is it "pleading for a discovery do-over." In fact, the Opposer is satisfied with its discovery efforts and would be willing to allow Applicant to conduct further discovery, while refraining to do so itself. In support of this statement, Opposer respectfully notes that in its Brief, it stated that "the Plaintiff is more than willing to reopen and extend the discovery period to allow the Applicant the opportunity to conduct further discovery pertaining to the new issues raised by the proposed amendment to the Opposition, as was allowed in *Anheuser-Busch, Inc. v Martinez,* 185 USPQ 434, 435 (TTAB 1975)."

In conclusion, the Opposer respectfully requests that these points and comments be taken into consideration when ruling on the Opposer's Motion For Leave to File An Amended Notice of Opposition. Thank you for your time and consideration.

Respectfully Submitted,

By: Philip Greene Date: 6-8-2015

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Certificate of Service

I hereby certify that a true and complete copy of the foregoing has been served on Peter Healy by mailing said copy on the date shown below, via postage pre-paid, first-class mail to the following address:

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Respectfully submitted,

By: Philip Greene Date: 6-8-2015

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